

**REMARKS**

Applicants acknowledge receipt of the Examiner's Office Action dated September 17, 2008.

Claims 27-49 are pending in the application.

Claims 27-49 stand rejected.

*Rejection of Claims Under 35 U.S.C. § 102*

Claims 27-49 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,064,987 to Walker, *et al.*, (*Walker*). Applicants respectfully traverse each of these rejections. While not conceding that the cited reference qualifies as prior art, but instead to expedite prosecution, Applicants have chosen to respectfully disagree and traverse the rejection as follows. Applicants reserve the right, for example, in a continuing application, to establish that the cited reference, or other references cited now or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

As will be appreciated, "[a] ... claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants respectfully submit that this burden has not been met by the instant Office Action, because, as will be shown below, independent Claim 27 recites at least one limitation that is not disclosed, either directly or under the principles of inherency, in *Walker*.

As an initial matter, *Walker* differs from the present invention in scope and purpose. These differences in scope and purpose are reflected in a comparison

Applicants' Claim 27 and the abstract of *Walker*. Claim 27 recites:

A computer program product comprising:  
a data structure for an order processing system comprising a complex object comprising a service profile, wherein the service profile represents an asset associated with an account, wherein said asset is a complex asset;  
a data manager configured to:  
    receive at least a portion of the service profile from an external server via an information network, and  
    generate a business object based on the portion of the service profile;  
a transformation engine configured to generate at least a portion of the complex object based on the business object, wherein the complex object is stored in an asset table; and  
computer readable storage media, wherein said data structure, said data manager, and said transformation engine are encoded in said computer readable storage media.

See Claim 27. By contrast, *Walker* teaches:

A central controller receives from a POS terminal a purchase price and a financial account identifier. The financial account identifier specifies a financial account, such as a credit card account. The central controller, in turn, generates one or more installment plan identifiers defining installment plans for payment of the purchase price. The installment plan identifiers are based on the purchase price and/or the financial account identifier. For example, certain accounts or certain high purchase prices may merit preferred installment plans. The installment plan identifiers are transmitted to the POS terminal. A purchaser at the POS terminal selects whether he would like to pay for his purchase in installments and, if so, using which installment plan. The POS terminal generates a selection signal indicative of whether to accept any of the installment plans, and transmits the selection signal to the central controller. The central controller receives the selection signal. If the selection signal indicates acceptance of any installment plan, use of the accepted installment plan for the financial account is authorized. Thereafter, bills are generated which reflect installment charges to be paid.

*See Walker*, Abstract. Regarding the subject matter recited in Claim 27, while *Walker* is directed to a central controller, which receives from a POS terminal a purchase price and a financial account identifier, the claimed invention is directed to, for example, a computer program product for an order processing system, which comprises a complex object, a data manager for receiving a portion of a service profile from an external server, and a transformation engine. These differences, which are directed to specific elements that are not present in *Walker*, are articulated in Applicants' Claim 27 and serve as evidence of the inability of *Walker* to anticipate the claimed invention.

For example, the Final Office Action fails to demonstrate that *Walker* discloses the "data manager configured to: receive at least a portion of the service profile from an external server via an information network, and generate a business object based on the portion of the service profile" recited in independent Claim 27. The Final Office Action asserts that "the data manager is the database (42)." Applicants respectfully submit that this mapping of elements contradicts the plain teaching of the reference. In describing the components illustrated in Figure 4, *Walker* unequivocally identifies element 42 as "data storage device 42, such as RAM, floppy disk, hard disk, or combination thereof." *See Walker*, Column 6, lines 9-14. Quoted more extensively, the nature of data storage 42 becomes clearer. The cited text states:

FIG. 4 illustrates the central controller 12 of FIG. 1 in more detail. The central controller 12 comprises a controller processor 40, such as one or more conventional microprocessors, which is connected to a data storage device 42, such as a RAM, floppy disk, hard disk or combination thereof. The controller processor 40, and

thus the central controller 12, is further connected to the POS processors 20, 22 and 24 of FIG. 2.

*See Walker*, Col. 6, lines 9-16. Applicants respectfully submit that the Final Office Action's assertion that storage device 42 is "a database" and therefore teaches the claimed "data manager" is not compatible with *Walker*'s teaching that storage device 42 is RAM. This lack of correspondence between the elements of Claim 27 and the teachings of *Walker* renders *Walker* incapable of anticipating Applicants' Claim 27.

Applicants further respectfully submit that data storage device 42 is not "configured to receive at least a portion of the service profile from an external server via an information network," as no such external server is taught by *Walker*. The Final Office Action states that "The data manager (42) receives service profile information from point of sale (POS) terminals (20-24) via an external server" (col. 5, lines 49-51). The cited text of Col. 5 describes Figure 3 when it states:

For example, the POS terminal 20 may comprise one or more computers connected to a remote server computer for maintaining databases.

*See Walker*, Col. 5, lines 49-51. As is shown below in the inline reproduction of Figure 3, a quick glance at Figure 3 is particularly informative as to what is fairly taught by the cited section of *Walker*.

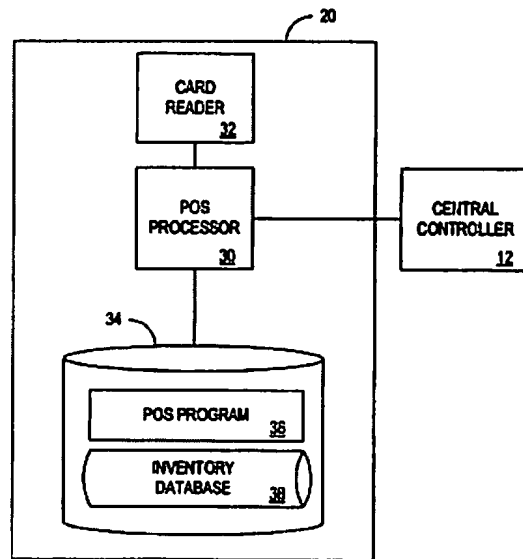


FIG. 3

See *Walker*, Figure 3. Thus, in addition to lacking a data manager, a point which Applicants have established above, *Walker* also fails to teach the claimed external server. To the contrary, *Walker* teaches away from the existence of anything even remotely comparable to the claimed external server by directly coupling POS terminal 20 and Central Controller 12 in Figure 3. Claim 27, by contrast, recites a “data manager configured to: receive at least a portion of the service profile from an external server via an information network,” which is not taught (or even suggested) by *Walker*.

Applicants further respectfully submit that *Walker* does not teach a “data manager configured to... generate a business object based on the portion of the service profile.” The Office Action states, “Business objects (installment plans—FIG. 5E) are generated and correlated to each of the complex objects (row 130).” Here, Applicants respectfully note that the Final Office Action alleges that business objects exist, but the Final Office Action points to no text indicating

where, how or by what they are generated, and particularly does not allege that a data manager is configured to generate the business objects as required by Claim 27. Neither text nor any drawings are offered to demonstrate that RAM (storage unit) 42 is in any way “configured to... generate a business object based on the portion of the service profile.” Without a teaching of any particular element in *Walker* being “configured to... generate a business object based on the portion of the service profile,” the Final Office Action does not state *prima facie* case of anticipation against Claim 27.

The Examiner has courteously attempted to respond to this argument at page 6, stating:

It is a well settled rule that a reference must be considered not only for what it expressly teaches but also for what it fairly suggests.  
*See In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979).  
And *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976)

*See* Final Office Action, Page 6. Applicants respectfully submit that, without regard to the accuracy of the Final Office Action’s assertions (a notion on which Applicants need not comment for reasons made clear below), the legal standard for anticipation under 35 U.S.C. § 102 is that “Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations.” *See RCA Corp. v. Applied Digital Signal Systems, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984).

Applicants respectfully submit that the Final Office Action conflates the relevant standard under 35 U.S.C § 102 (which is disclosure) with the relevant legal standard

under 35 U.S.C. § 103 (which is mere teaching or suggestion). The tests for anticipation and obviousness differ markedly. Succinctly put, the several forms of anticipation and loss of right under § 102, and obviousness under § 103 require different elements of proof. *See, e.g., Duro-Last, Inc. v. Custom Seal, Inc.*, 321 F.3d 1098, 1107-08 (Fed. Cir. 2003). If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation, but § 103 obviousness. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1577 (Fed. Cir. 1991). The “suggestion,” which reaches beyond the four corners of the reference, advocated by the Final Office Action in the paragraph cited above, demonstrates that the Final Office Action attempts to impermissibly substitute the “teaching or suggestion” requirement of § 103 for the “disclosure” requirement of § 102. A *prima facie* case of anticipation under § 102 is not and cannot be establish, as the Final Office Action attempts, with the merely alleged suggestions that the Final Office Action urges.

Each of the authorities (*Burckel* and *Lamberti*) cited for the “suggestion” argument above, is inapplicable to the current rejection under 35 U.S.C. § 102, as each case seeks to define requirements under the separate inquiry of 35 U.S.C. § 103. Starting with *Burckel*, the text of the cited opinion clearly states:

This appeal is from the decision of the Patent and *Trademark* Office (PTO) Board of Appeals (board) affirming the examiner's rejection of claims 1-3 and 6 under 35 U.S.C. § 103 in application serial No. 511,028, filed September 30, 1974, entitled "Product."

...

The examiner held the subject matter of the appealed claims unpatentable as obvious under § 103 from Economy.

*See Burckel*, publicly available at <http://vlex.com/vid/38402605>. *Lamberti* suffers the same deficiency of inapplicability under 35 U.S.C § 102, stating:

This appeal is from the decision of the Patent and Trademark Office (PTO) Board of Appeals (board) affirming the rejection under 35 U.S.C. § 103 of claims 1 and 8 in application serial No. 114,034, filed February 9, 1971, entitled "Hydroxyaryldialkyl Sulfonium Halides."

...

The examiner rejected the claims, inter alia, under 35 U.S.C. § 103 as obvious in view of either MacGregor or Cisney.

The board affirmed only the 35 U.S.C. § 103 rejection, holding that it would have been obvious to use an asymmetric dialkyl thioether in the disclosed process of MacGregor or Cisney to produce a hydroxyphenyl dialkyl sulfonium halide having an asymmetric dialkyl grouping.

*See Lamberti*, publicly available at <http://vlex.com/vid/38401919>. Clearly, without regard to what is taught by *Burckel* and *Lamberti*, their explanations of "suggestion" for obviousness under 35 U.S.C. § 103 are an inappropriate and inapplicable buttress for an argument of "disclosure" for anticipation under 35 U.S.C. § 102.

The Final Office Action further states that "it is an equally well-settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts. *See In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956)." Applicants choose not to (and need not) discuss the accuracy of the assertion that "it is an equally well-settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts." The cited case is obviously irrelevant to the Final Office Action's argument under 35



U.S.C. §102, because the case is explicitly pointed to 35 U.S.C. § 103. The Final Office Action rejects the present claims as purportedly lacking novelty under 35 U.S.C. § 102. In offering *Bascom* in support of the § 102 argument, the Final Office Action chooses to buttress the argument of a lack of novelty with authority pointed to the law of obviousness (35 U.S.C. § 103). The text of *Bascom* is entirely clear on its status as interpreting the law of obviousness. It states:

The following references were relied on by the Patent Office:  
Wendelken 1,238,704, Aug. 28, 1917; Lunken 1,326,676, Dec. 30, 1919; Carter 2,540,864, Feb. 6, 1951.

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The Carter patent was selected as the basic reference, and the claims were rejected as unpatentable over Carter in view of Lunken or Wendelken. Carter shows

...

Referring now to the appealed claims, and particularly to claim 10 quoted supra, we find that the common thread running through all of them is the concept of having a door with a plurality of screen windows and a plurality of transparent windows, which are adapted to slide selectively from the door opening to a storage compartment below the opening. The Carter reference shows a door with an opening and an adjacent storage compartment, and the other references show a plurality of window units adapted to slide selectively between the window opening and an adjacent storage compartment. *In this situation, the only question is whether it is proper to combine the references.* (Emphasis added).

*See In re Bascom*, available at

<http://bulk.resource.org/courts.gov/c/F2/230/230.F2d.612.6156.html>. *Bascom* argues

obviousness in the 1950s. The Final Office Action rejects for an alleged lack of novelty.

The two are separate legal standards.

The Final Office Action also calls attention to “*In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977), which indicates such fair suggestions to unpreferred embodiments must be considered even if they were not illustrated.” Applicants are unclear as to how this case applies to the arguments at hand. Unlike the non-preferred embodiment of *Bode*, which the Final Office Action presents as being disclosed (notwithstanding that the embodiment is not illustrated), Applicants respectfully submit that *Walker* has not disclosed the recited data manager and the recited external server, as discussed above. The Final Office Action fails to address (in a response to arguments) Applicants’ assertion that the data manager and external server are not taught. Similarly, the Final Office Action states:

Applicant’s first argument is that the reference in *Walker* is directed to a different scope and purpose.

Examiner disagrees. This argument is moot. The legal question under 35 U.S.C. 102 is whether the prior art anticipates certain claimed features, not whether its overall scope and purpose are identical to what is claimed.

*See Final Office Action, Page 6.* The Final Office Action correctly argues that the standard is disclosure of each element. Applicants have noted the differences in scope and purpose to provide an intellectual framework in which the deficiencies of *Walker* make sense. Applicants respectfully re-urge that these differences in scope and purpose lead to specific elements, not present in *Walker*, which are articulated in Applicants’ Claim 27 and which serve as evidence of the inability of *Walker* to anticipate the claimed invention. Stated alternatively, *Walker* does not anticipate the present invention because *Walker* lacks several specific elements of the recited claim. That *Walker* should lack these recited elements is not a surprise

to one having ordinary skill in the art; the tools appropriate to Applicants' claims are not seen in *Walker* because *Walker* is not directed to, for example, a computer program product for an order processing system, which comprises a complex object, a data manager for receiving a portion of a service profile from an external server, and a transformation engine.

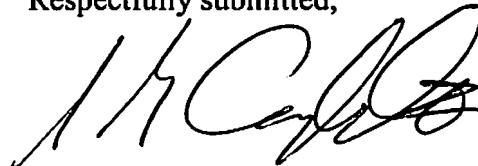
Applicants respectfully submit that *Walker* does not support a *prima facie* case of anticipation of Claim 27 by teaching each limitation of independent Claim 27; Claim 27 is therefore allowable over *Walker*. Applicants thus respectfully urge the Examiner withdraw the § 102 rejection of Claim 27. Applicants further respectfully submit that dependent claims 28-49 are allowable as depending upon allowable base claims in addition to being allowable for various other reasons. Applicants therefore respectfully request a that the Examiner withdraw the rejections of each of Claims 27-49 and issue an indication of the allowability of all pending claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. G. Campbell III', with a stylized flourish at the end.

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